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Lev Ring

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EXAMINER

BRINSON, PATRICK F

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,029,748 to **Forsyth et al.** in view of U.S. 5,427,698 to **Hirokawa et al.**

The **Forsyth et al.** reference discloses a method and apparatus for radially expanding and plastically deforming expandable tubular assembly including one or more tubular members, comprising coating the interior surfaces of the tubular members with a lubricant, positioning the tubular members within a pre-existing structure and radially expanding and plastically deforming the members within the pre-existing structure. The tubular members are disclosed as being underground in a wellbore casing. **Forsyth et al.** discloses the recited structure, but it does not specifically disclose the composition of the lubricant. The patent to **Hirokawa et al.** discloses a coating composition for lubrication including a solvent carrier, in the form of 47 to 50% methyl ethyl ketone, a dry lubricant material used preferably in an amount of 20 to 80%, of materials, including polytetrafluoroethylene and an adhesive

in the form of an alkyd polymer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the lubricant of **Forsyth et al.** with the lubricant as suggested by **Hirokawa et al.** wherein it is known to provide lubricants including the recited elements in the recited percentage weights or very close to the recited ranges for protection of machine surfaces against seizure and abrasion loss, since a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough where a prima facie case of obviousness exists. **Forsyth et al.** discloses the tubular members being utilized underground in a wellbore, but does not specifically disclose the tubular members as structural supports, however, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

2. Claims 149-152 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Forsyth et al.** in view of **Hirokawa et al.** and **Nishizaki et al.**

As discussed in the preceding paragraph, **Forsyth et al.** discloses an expandable tubular assembly including the use of lubricant coupled to the interior surfaces of the tubular members. **Forsyth et al.** does specifically disclose the composition of lubricant. **Hirokawa et al.** discloses a lubricant a coating

composition for lubrication including a solvent carrier, in the form of 47 to 50% methyl ethyl ketone, a dry lubricant material as low as 20% polytetrafluoroethylene and an adhesive in the form of an alkyd polymer. If it is desired to provide a coloring pigment to the lubricant, **Nishizaki et al.** discloses that it is known to provide titanium dioxide and to provide dispersants such as calcium silicate to disperse pigments insoluble in organic liquids dispersed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute for the lubricant of **Forsyth et al.** a lubricant including a solvent carrier, a dry lubricant material, an adhesive, as taught by **Hirokawa et al.** wherein it is known to provide lubricants including the recited elements in the recited percentage weights for protection of machine surfaces against seizure and abrasion loss, and to provide , a pigment and a dispersant for the pigment as taught by **Nishizaki et al.** in order to provide the lubricant with a color.

Response to Amendment

3. The claims have been amended in an attempt to overcome the rejection of **Forstyth et al.** in view of **Hirokawa et al.**, wherein **Forsyth et al.** discloses the recited structure including a lubricant on the interior surfaces of the tubular members and **Hirokawa et al.** discloses the lubricant including the recited materials, including the dry lubricant as being polytetrafluoroethylene, wherein **Hirokawa et al.** discloses

that solid lubricants are used preferably in an amount of 20 to 80%. Applicant's specification discloses in several instances that the dry lubricant is indeed above 20%. Paragraph 0056 discloses 1 to 40% PTFE, paragraph 0058 discloses 1 to 25% PTFE, as well as paragraphs 0060 and 0061 disclose 1 to 40% PTFE. Therefore it is clear that one skilled in the art may use a varied amount of a dry lubricant, wherein the dry lubricant is PTFE. To modify the claims to less than 20% does not distinguish the present invention over the prior art, wherein a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough where a prima facie case of obviousness exists. Less than 20% could be 19.99%, and though **Hirokawa et al.** "preferably" discloses at least 20%, it would be obvious to utilize the lubricant of **Hirokawa et al.** with the method and apparatus of **Forsyth et al.**, wherein the recitation of less than 20% dry lubricant does not distinguish the present invention from the combination of **Forsyth et al.** and **Hirokawa et al.**

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Patrick F. Brinson** whose telephone number is (571) 272-4897. The examiner can normally be reached on M-F 7:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Kevin P. Shaver** can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patrick F. Brinson/
Primary Examiner, Art Unit 3754

P. F. Brinson
May 7, 2008